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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)  
85804-019501

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Signature



Typed or printed  
name Suzanne Marx

Application Number  
09/903,033

Filed  
July 10, 2001

First Named Inventor  
Jeffrey R. Boulter, et al.

Art Unit  
2143

Examiner  
Arrienne M. Lezak

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

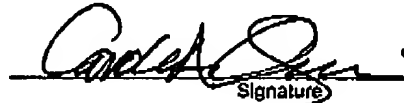
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I am the

- ☐ applicant/inventor.  
☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 39,000

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

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(714) 708-6500  
Telephone number

August 4, 2006  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 4 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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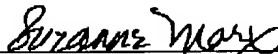
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 09/903,033      Group Art Unit: 2143  
Applicant(s): Jeffrey R. Boulter, et al.      Examiner: Arrienne M. Lezak  
Filing Date: July 10, 2001      Docket No. 85804-019501  
Title: ONLINE PLAYBACK SYSTEM WITH COMMUNITY BIAS      Customer No. 32361

## CERTIFICATE UNDER 37 CFR 1.6(d) and 1.8

I hereby certify that this correspondence and identified enclosures are being transmitted via facsimile only to the United States Patent and Trademark Office, Facsimile No. (571) 273-8300 on August 4, 2006.

  
Name: Suzanne Marx

**LETTER SUBMITTING REMARKS WITH  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Date: August 4, 2006

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir/Madam:

This paper is being filed with a Request For Pre-Appeal Brief Review and a Notice of Appeal. Applicants seek formal review by a panel of examiners of the claim rejections raised in an Office Action mailed April 7, 2006 (hereinafter referred to as the "Office Action"). By the Office Action, at least one claim stands twice rejected. Accordingly, appeal of the rejection, and request for pre-appeal brief review are timely and proper.

More particularly, Applicants request review of the 35 U.S.C. § 112, first and second paragraph rejections of Claims 3, 6, 9, 14, 17, 22, 25, 28, 31, 34, 37 and 41, and the 35 U.S.C. § 103(a) rejection of Claims 1 to 42 based on U.S. Patent No. 6,192,340 (Abecassis) and U.S. Patent No. 5,926,207 (Vaughan). The remarks made herein supplement Applicants' remarks of record in the instant case.

Taking the 35 U.S.C. § 112 rejections first, the Office Action focuses on the use of the phrases "first community" and "second community," and contends that "a second community, inherently and by its nature, cannot in any way exist without a first community" and it is therefore concluded in the Office Action that "a first community cannot in any way ever be determined from a second community." The Office Action further contends that Applicants'

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specification “does not reasonably provide enablement for evaluating preferences of a second community in order to determine a first community from a second community.”

In response, the words “first” and “second” are used merely to differentiate between one community and another community, and such use is a common and accepted convention.

Reference is respectfully made to *3M Innovative Properties Co. v. Avery Dennison Corp.*, 69

USPQ2d 1050 (Fed. Cir. 2003), wherein the court stated:

“[t]he use of the terms ‘first’ and ‘second’ is a common patent-law convention to distinguish between repeated instances of an element or limitation. *See, e.g., Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 67 USPQ2d 1865 (Fed. Cir. 2003) (‘first and second sidewall surfaces’); *Springs Window Fashions LP v. Novo Indus., L.P.*, 65 USPQ2d 1826 (Fed. Cir. 2003) (‘first and second opposed ends’). In the context of claim 1, the use of the terms ‘first ... pattern’ and ‘second ... pattern’ is equivalent to a reference to ‘pattern A’ and ‘pattern B,’ and should not in and of itself impose a serial or temporal limitation onto claim 1.” *Id* at 1055.

Referring to Claim 3, for example, the terms “first” and “second” are used to differentiate between first and second communities, the former being determined from the latter. As indicated by the court in the above-quoted case, this is a common and acceptable use of these terms. Furthermore, the Application provides more than adequate support for determining a first community from a second community. For one example, and without limitation, reference is respectfully made to page 9, lines 5 to 9, which provides a description of selecting a first community, from a subscriber database, or a second community, the members of the first community having expressed a preference (e.g., provided a rating of 70 or more on a “favorite artist” scale from least favorite, 0, to most favorite, 100, for the singer Tori Amos). The foregoing discussion should provide more than ample reason to withdraw the 35 U.S.C. § 112 rejections, and such action is respectfully requested.

Turning now to the other rejection of the claims, Claim 1 recites a method for providing a data stream according to preferences of a community. A first community of members is provided, each member of the community having corresponding preferences regarding data stream content. The members of the first community are determined to have at least one preference in common. Characteristics of the preferences of the first community’s members are determined, and an individual data stream is biased according to the determined characteristics of the first community members’ preferences. The individual data stream has more content that the community likes and less content that the community dislikes.

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The applied art, namely Abecassis and Vaughn, fails to teach, suggest or disclose the claimed invention. The applied art fails to teach, suggest or disclose at least the features of biasing an individual data stream according to determined characteristics of a first community members' preferences regarding data stream content, the first community members determined to have at least one preference in common, such that the individual data stream has more content that the community likes and less content that the community dislikes.

In response to Applicants' previous remarks, the Office Action states (at page 11):

"[r]egarding Applicant's argument that categories of music do not read on communities of music, Examiner respectfully disagrees. Specifically, Examiner makes reference to Applicant's own specification, (pp. 7-13), wherein Applicant states, 'it is yet another object of the present invention to provide community biased music data stream according to a community expressing preferences for music carried by said data stream, such as artist or genre'. Thus, Examiner maintains that a category of music, (i.e.: Mozart or classical music), clearly and obviously reads upon a community comprised of listeners who prefer the respective classical music artist or genre."

It is respectfully submitted that the Office Action mischaracterizes Applicants' previous remarks<sup>1</sup>, which stated that the music categories described in Abecassis cannot be equated to a member community which expresses preferences for music. A category of music, such as Mozart or classical music as pointed out in the Office Action, clearly cannot be said to be the same as a community whose members express preferences for such a category of music, for example, let alone a community whose members are determined to have at least one preference in common.

The portion of Applicants' specification identified in the above-quoted excerpt of the Office Action clearly cannot be said to state or even imply that a community expressing preferences is the same as a category of music, an artist, a genre, for example, for which members of a community might express a preference. This is not only clear from reading the portion of Applicants' specification identified (and quoted) in the Office Action, but is also clear from a reading of the specification as a whole. A community expressing preferences for an item, such as a category of music, clearly cannot be said to be the same as the item for which the community expresses a preference.

The Office Action further refers to MusicMatch Jukebox and RealJukebox and "radio-on-demand stations," and contends that a number of users choosing from "available radio-on-

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<sup>1</sup> It is unclear what the Office Action means by the phrase "communities of music," and further clarification is respectfully requested.

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demand stations" forms a community of individuals with similar musical preferences. The conclusions reached in the Office Action presupposes features that simply are not disclosed, suggested or even supported by the applied art. As is stated in Abecassis, MusicMatch Jukebox and RealJukebox are software media players used to play music, and an individual user can access a radio station using the player software. This cannot be said to disclose or suggest the claimed limitation of determining a community whose members are determined to have at least one of their preferences in common.

While the Office Action identifies one section of Abecassis, i.e., col. 17, lines 46 to 49, which mentions a plurality of users, this portion of Abecassis is taken completely out of its context in relation to the claims, and merely concerns an information provider examining requirements of a plurality of users so that the information provider can allocate its information gathering resources to gather informational items. Abecassis does not determine commonality of preferences of these plurality of users. Rather, this portion of Abecassis is simply examining each of the individual user's preferences to determine requirements that each user needs in order to allocate information gathering resources to gather the information required by each individual user. Nothing in the cited portion discloses or even suggests a community whose members are determined to have at least one of their preferences in common, nor even suggest biasing an individual data stream in accordance with characteristics determined from the preferences of community members, such that the individual data stream is biased according to the determined characteristics of the preferences, and biased according to the community members' preferences.

Rather, and as is supported by the portions of Abecassis cited in the Office Action, Abecassis focuses on the individual user, and on playing music for the individual user from the user's own music collection based on user's individual preferences, and nothing in Abecassis describes, suggests or in any way discloses a determined community whose members are determined to have at least one preference in common.

To overcome this shortcoming the Office Action relies on Vaughn as allegedly disclosing a community. However, Vaughn describes a system which allows a user to define behavior for a broadcast channel independent of other broadcast channels. Vaughn describes a database which maintains a master list of broadcast channels, each channel having associated programmable data, which allow a user to define the behavior of a broadcast channel independent of the other broadcast channels. At col. 2, lines 24 to 27, Vaughn describes that the programmable data can

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allow the user to have a particular logo associated with a broadcast, such that the logo would be displayed when the user's television was tuned to the specific broadcast channel.

While Vaughn indicates that the master broadcast channel list can be subdivided into lists based on channel type, a listing of channels is certainly not the same as a community with members each of which have associated preferences regarding data stream content, and/or a community of members determined to have at least one of their respective preferences in common, determining characteristics of the community members' preferences, and/or biasing an individual data stream in accordance with the determined characteristics, such that the individual data stream is biased according to the community members' preferences.

Furthermore, and while the above reasons should be sufficient to withdraw the rejection, the rejection should be withdrawn for the reason that there has been no showing in the Office Action of a suggestion, teaching, or motivation that would have led a person of ordinary skill in the art to modify the teachings of the applied references in a manner that would have resulted in the claimed invention.<sup>2</sup> Without such a showing, it can only be said that the disclosure of the present application is being used as a blueprint to modify the teachings of the applied art to reject the claims of the present invention.

For at least the reasons presented herein and in Applicants' remarks of record in the instant case, Applicants respectfully submit that withdrawal of the 35 U.S.C. §§ 112 and 103(a) is proper, and such action is respectfully requested. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2638. Please ensure that the Attorney Docket Number is referenced when charging payments or credits for this case.

Date: August 4, 2006

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Respectfully submitted,



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<sup>2</sup> Reference is respectfully made to Applicants' previous remarks.